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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/033,401

12/26/2001

Scott A. Rosenberg

03-380-C

1472

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04/08/2008

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EXAMINER

CARLSON, JEFFREY D

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

04/08/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/033,401	<b>Applicant(s)</b> ROSENBERG, SCOTT A.	
	<b>Examiner</b> Jeffrey D. Carlson	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-15 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-15 and 18-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/22/08, 4/5/07</u> .   | 6) <input type="checkbox"/> Other: _____                          |



## DETAILED ACTION

### *Claim Objections*

1. Claim 23 is objected to because of the following informalities:

- Claim 23 line 4, "time" should be replaced by "times".

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-3, 7-15, 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Chen et al (US7039933).**

4. Regarding claims 1-3, 11, 14, 15, 19-22, 24-26, Barton teaches a DVR with software that includes a bookending function which inserts & plays advertisements before and/or after a user-selected pre-recorded program is played [abstract, 0014]. Both the beginning and end of the requested play content is taken to represent detection of a mode change and triggers obtaining/determination of an appropriate advertisement. Regarding the claimed feature that the advertising is displayed along with the video of the two modes, Barton's disclosure about the bookending advertising feature does not appear to provide enough detail about the transition into the advertisement and the transition out of the advertisement. However, Chen et al teaches

that it is well known for displayed TV programming to include enhanced effects for the inclusion of advertisements. Specifically, Chen et al teaches that advertising enhancements may be displayed in a manner such that graphical and information (advertising) may be shown on the screen at the same time as the video program (reading on applicant's "mini-ad" as well as the display "along with video"). Chen et al mentions that the advertising may overlay the video program or may opaquely cover a part of the program or may be transparent or semi-transparent. The advertising enhancement may also be shown next to a shrunken-down version of the program or the advertising may be shown on the screen after the program has been blanked out. Given the wide variety of known techniques for displaying the advertising enhancements, it would have been obvious to one of ordinary skill at the time of the invention to have to have shown the triggered advertising of Barton in any of such manners for various effects. Placing Barton's advertising simultaneously on the screen with the video programming content provides overlap of advertising with the first and second display modes of Barton.

5. Regarding claims 7-10, 13, Barton teaches that the ads are pre-stored on the device and that they can be selected on the basis of the viewer's preferences and personal information [0015]. This is taken to provide a real-time and dynamic selection of ads based upon previously collected user information. Claim 10's "context information" is quite broad and could be met by virtually any information used for the bookend feature: the context that there is a transition to the start of a requested program, the context that there is a transition from the end a requested program, the

context that the ads are targeted to the audience that the viewer is a part of [0015], the context of the genre, etc. The bookend programming/functionality [fig 9: 904] is taken to provide an ad placement engine.

6. Regarding claim 12, while any moving video content can be taken to be animation (i.e. simple motion), Official Notice is taken that TV commercials have for decades included cartoon animation, such as the Snap, Crackle and Pop characters for Kellogg's Rice Krispies <sup>TM</sup>. It would have been obvious to one of ordinary skill at the time of the invention to have provided at least some of the advertisements of Barton as animations in a manner as well known.

7. Regarding claim 18, the bookending programming/functionality [fig 9: 904] is taken to receive notification from the viewer interface to change playback/mode; the bookending programming/functionality is taken to request/send the selected ad to the video decoder to be rendered on the screen before and/or after the requested program content.

8. Regarding claim 23, Chen et al's graphical enhancements (icons, banners, etc.) are taken to include still frames which are replicated so as to fill the desired screen display time.

### ***Response to Arguments***

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/  
Primary Examiner, Art Unit 3622

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Primary Examiner  
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jdc